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10/031,942	01/23/2002	Yehouda Harpaz		8389

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EXAMINER

HOTALING, JOHN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/031,942	Applicant(s) HARPAZ, YEHOUDA	
	Examiner John M Hotaling II	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Cancel Claim 1

Claim 2

Line 1 replace "1" with -- 5 --

Add Claim 5

5 (New) An electronic board comprising a grid of grid points on a flat surface, where each grid point is a visible element which is capable of detecting when it is pressed, and an illumination source inside or below the surface which is capable illuminating the visible element by either of two colours;

which exhibits a behaviour which makes it useful for playing various games;

and in one of these games the behaviour of the board is as follows:

the game starts with an equal number of points illuminated in each of the two colours;

when a player presses a point, the board switches off points in the current player's colour that are in a fixed pattern with respect to the pressed point and points in

the other colour that are in another fixed pattern with respect to the pressed point, and then makes the other colour the current player's colour

when all the points that are illuminated are illuminated in the same colour, the board declares the player of this colour as winner.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 1 been renumbered claim 5.

The applicant changed the limitations of old claim one but did not amend claim 1. The applicant should have either amended claim 1 or canceled claim 1 and added new claim 5.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "games manager" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. It seems that games

manager was inadvertently left in the claim when new claim 1 was presented. It should be removed.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,568,683. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 are essentially the same as claims 5 of the instant application.

Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/031,776. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the use of an electronic

game board for use in playing games with various sections illuminated in each of two colors.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 4 of copending Application No. 10/031,890. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the use of an electronic game board for use in playing games with various sections illuminated in each of two colors.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg et al. (US Patent No. 5,417,425) further in view of Lites Out!

Blumberg et al. disclose a grid of grid points on a flat surface where each grid point is a visible element (FIG 1-4) which is capable of detecting when it is pressed (Column 1, lines 22-30). Blumberg et al. also disclose an illumination source inside and below the surface which is capable of illuminating the visible element (FIGs 13-14) by either of two colors (Column 6, lines 37-40). Blumberg et al. disclose a game manager (FIG 9) connected electronically to the grid points (FIG 9, reference 20) as well as to the illumination source (FIG 9, reference 30). The microcontroller has control over the illumination and coloring of the squares (Column 4, lines 11-14). It also detects when a grid point is pressed (Column 4, lines 11-14). FIG 9 also shows a program and a memory associated with the CPU (microcontroller).

The CPU manages the game and when a player presses a point, the illuminations of a pattern of points around this point are changed (Abstract).

Blumberg et al. discloses that the CPU uses a program to control the illuminations and patterns. Though Blumberg et al. discloses two colors for use in the game, the disclosure does not explicitly state that when a player presses a point, the colors change to a player color if they were switched off or reverse colors if they were on. However, Lites Out! which is a mimic of the Blumberg et al. patent with an improvement consisting of using two colors and an off state does make the changes as

claimed. By using two colors and an off state, Lites Out! uses such a twist to make the game harder. Thus, the game would be more enjoyable to more experienced players who would less likely to tire of the game upon mastery. By adding a third color, thus a higher level of difficulty, one skilled in the art would recognize the added and lasting enjoyment that could be obtained. The function of the lights is disclosed as follows: In this mode, the object is the same, but each block can have 3 states; OFF, ON1 (yellow), or ON2 (blue). The direction the blocks change depends on the direction it was going and the state of the main block that is being switched. Thus, colors are either switched on or reversed depending on the state they were in.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the program disclosed by Lites Out! into a structure such as the one disclosed by Blumberg et al. As Lites Out! merely represents a program, it could easily be adapted or used by a skilled artisan to work in the structure of Blumberg et al. wherein its addition would add lasting enjoyment to the device. As Blumberg et al. already support multiple color lights as well as an off state, one would be motivated to do this, as discussed above, to provide a more challenging and testing device to continue to face and amuse experienced players; thereby, not alienating them when they learn and grow tired of the simplified Blumberg et al device.

Blumberg et al. also states that the objective is to go from a starting configuration of indicator states to a desired configuration of indicator states (Column 2, lines 22-24). Blumberg et al. follows with the example of an ending configuration where all the indicators are of the same state, i.e. lit (Column 2, lines 25-30). Blumberg et al. is very

open about what the goals can be and designates other possible ending configurations, thus indicating other such ending points would be of a design choice. In the above named case, the player would have the majority of the lights on, as that would be the ending phase.

Blumberg et al. also does not disclose a character display. However, Bloomberg et al. does disclose an audio device, which is used to provide feedback information (Column 4, lines, 15-17). It would be obvious to a skilled artisan that in providing feedback, the device would indicate a win, as is known in the art, in order to stimulate the player and provide encouragement and recognition. Further, it would have been an obvious design choice to employ a display as opposed to an audio device as both satisfy the requirement of providing feedback to the player. One motivation for using a character display would be that the player could play the game without disturbing others (i.e. in cars, planes, or trains), yet still receive feedback. This device would be used in the Blumberg et al. system to indicate to the player they are the winner as all the points are switched on and therefore have the majority.

Regarding claim 4, Blumberg et al. states that the determination of which indicators change state upon the selection of one of the indicators is made based on the preset pattern or algorithm (Column 3, lines 5-7) and also states that the device can change the state of at least one of the non-selected indicators, perhaps also changing state of a selected indicator (Column 3, lines 1-3) thus suggesting that the board performs changes only when an non-illuminated point is pressed as Blumberg et al. indicates it is not required that the state of a selected indicator must be changed, it is

only requires that at least a non-selected indicator be changed. One of ordinary skill in the art would be able to readily understand that any preset pattern may be used.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg et al. (US Patent No. 5,417,425) further in of Weiner et al US Patent 5,573,245.

What Blumberg et al. discloses, teaches, and/or suggest has been discussed above and is incorporated herein.

Blumberg discloses all of the instant application as taught above but does not specifically disclose different specific patters that arise when a player touches a point on the playing field. In an analogous invention to Weiner as can be seen in figures 1-4 and columns 2-4 specifically 4:50-65 that the changing of the states of the indicators based on selections by the user may be one or more pre-determined geometrical pattern or other algorithm. The references are of analogous subject matter in that the object of the game is to make the game board a solid color. One would be motivated to do this, as discussed above, to provide a more challenging and testing device to continue to face and amuse experienced players; thereby, not alienating them when they learn and grow tired of the simplified Blumberg et al device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a game board with varying patterns as disclosed in Weiner in order to have a game which varies.

Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

British Othello Federation ® and Internet Archive Othello Describes the rules of the known game of Othello and how the game is played.

US Patent No. 5,603,500: Puzzle device that allows for the user to press buttons and change the color of the state and the surrounding buttons.

US Patent No. 5,743,796: Game with a plurality of spaces with indicators and a game for uses lights to control states.

Skowronski '979, Ghaly '037, both disclose a puzzle device that allows for the user to press buttons and change the color of the state and the surrounding buttons.

Response to Arguments

7. Applicant's arguments with respect to claims 4 and 5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is 703 305 0780. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 305-7497. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. HOTALING, II
PRIMARY EXAMINER

July 20, 2004

